

Applicant Docket No. 19011.1140

REMARKS

This paper is responsive to the Office Action mailed March 30, 2004.

~~At the mailing of the Official Communication, claims 1-12 were pending and the Patent~~

Office has set forth grounds for rejecting each of these claims. Claim 3 has been amended only to provide more specificity in the language of the claim. The applicant submits that the claims are allowable in view of the art cited by the Patent Office and respectfully request the Patent Office to remove the present rejection from these claims. The applicant's traversals of the Patent Office's rejections are provided below. These arguments are similar to the arguments presented in a December 8, 2003 response to the Office, however, additional descriptions have been added in support of the arguments. This is not a cut and paste response and the applicants respectfully request the Office to actually READ these arguments in that they have paid an attorney a considerable amount of money in order to author these arguments for the benefit of the Office.

The applicant's respectfully question whether the Office actually read the December 8, 2003 response in that the Office has not responded to changing the docket number, which was clearly requested in 20 point font, and the Office has not indicated whether the applicant's submission of an abstract was accepted – in fact the Office does not even acknowledge the reception of the abstract.

Paragraphs 1 and 2 of the Official Action do not require a response.

Paragraph 2 sets forth the basis for a rejection under 35 USC §103 and does not require a response.

Paragraph 3 sets forth rejections for claims 1-12 under 35 USC §103(a) alleging that the claims are unpatentable over U.S. Patent No. 6,104,722 to *Stewart* in view of U.S. Patent No. 5,508,731 to *Kohorn*. The applicant respectfully traverses these rejections.

The Official Action alleges that column 8, lines 55-60 of *Stewart* discloses the element of electronically communication the commercial to the prospect and the prospect making a response to the commercial. The applicant respectfully disagrees with this allegation.

The invention as recited in claim 1 includes an **advertiser** that performs a process, this process includes (a) selecting a prospect, (b) selecting a commercial and (c) identifying that

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selection to a third party. The third party then electronically communicates the selected commercial to the selected prospect. The selected prospect can then make a response to the selected commercial and that response is tracked by the third party. Finally, the third party provides information relating to the selected prospects response regarding the selected commercial to the advertiser.

Stewart simply describes an information communication system that includes a plurality of nodes that are connected through a communication means. *Stewart* focuses on setting up appropriate communication protocols and resource allocations to efficient transfer information between nodes. Thus, the invention described in *Stewart* allows a device acting as a message source to communicate with another device at a first node using a first protocol and to communicate with a different device at a second node using a second protocol.

Stewart simply describes a communication infrastructure and does not describe, suggest or teach, nor would it be obvious from reading the *Stewart* reference, an advertiser selecting a prospect and a commercial, communicating that selection to a third party, delivery of the commercial to the selected prospect, tracking response information and reporting the response information to the advertiser.

The Patent Office admits that *Stewart* does not teach an advertiser manually selecting an individual prospect and an individual commercial and identifying that selection to a third party. The applicant respectfully submits that *Stewart* lacks much more than this. *Stewart* simply talks about information being delivered to multiple nodes using different protocols. The Patent Office alleges that the "second node" in *Stewart* is equivalent to the prospect. However, the prospect recited in claim 1 is an entity that can view a commercial and respond to the commercial. The "second node" in *Stewart* is a piece of hardware that receives a communication. There is no similarity.

Please note, the Office raising *Stewart* as a basis for a 103 rejection is border line criminal. It is about as relevant as raising the existence of a piece of copper wire as prior art for the Public Switched Telephone Network. The applicant challenges the Office to point to one location in *Stewart* that would give rise to the elements of the claims other than the fact that both

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the recited claims and *Stewart* involve the transmission of electronic signals. *Stewart* has not mention of an advertiser, a prospect, a commercial, selecting a prospect, selecting a commercial, providing the commercial and identification of a prospect to a third party, allowing the third party to communication the commercial to the prospect, obtaining feedback and reporting the feed back to the advertiser. The applicant encourages the Office to either find relevant art or to remove the rejection and allow the claims to issue.

The Patent Office further alleges that it would have been obvious to modify the teachings of *Stewart* to include *Kohorn* in order to perform the steps of an advertiser manually selecting an individual prospect and an individual commercial, and identifying the selection to a third party. The applicant, once again, respectfully disagrees.

Kohorn describes broadcasting an instructional signal that is modulated onto a television program signal. So firstly, *Kohorn* and *Stewart* in no way describe selecting a commercial and selecting a prospect. If the Office disagrees, the applicant respectfully requests the Office to provide a clearly articulated basis for this disagreement. Simply citing column 8, lines 45-60 of *Stewart* is not considered a clearly articulated basis. This reference does not use the words, or any synonym for "selecting a commercial and selecting a prospect." Thus, combining the two references in the most liberal fashion would only result in broadcasting an instructional signal embedded in a television programming signal. There is no implication whatsoever that the broadcast is limited to particular prospects or a single prospect, it is a broadcast signal. Thus, there are no prospects to select from and it would not have been obvious to add this element to the combination of *Kohorn* and *Stewart* because there would be no reason to identify prospects for a broadcast signal since all capable receivers can receive the signal.

Let's look at a specific argument raised by the Office. The Office admits that *Stewart* fails to teach an advertiser narrowly making a selection of a prospect and a commercial, and identifying the selection to a third party. The applicant agrees. However, the Office then cites references in *Kohorn*, alleging that (a) it would be obvious to incorporate these references into *Stewart* and (b) that doing so would render the claim obvious. These are the following points the Office cites regarding *Kohorn*:

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(1) Kohorn discloses providing a member of the audience with a means for entering a response to a situation viewed on the television screen and/or heard via the speaker, not accepting (rejection) or accepting, evaluating and scoring such response, recording such response, and outputting a temporary or permanent record of the response, and a permanent record is in the form of the card, which form is machine readable to facilitate a reading of the score and/or response by either a third party or the host (see column 18 lines 10-15)

(2) Kohorn discloses communicating the identities of a winner selection station (see column 128 lines 40-50).

The applicant respectfully requests the Office to clearly identify in these two passages where an (a) "advertiser narrowly makes a selection of a prospect" (b) "an advertiser selects a commercial and (c) the advertiser communicates these items to a third party. The answer is clear, there is no such disclosure. It is not appropriate to combine *Stewart* and *Kohorn* in this situation and the combination of the two references do not disclose the elements of the claim and thus, they do not render the claim obvious.

Thus, the Office's position that claims 1-3 and claim 12 are unpatentable should be withdrawn in the absence of citing relevant art.

Therefore, the applicant respectfully submits that claim 1-3 and 12 are allowable over the cited art. In addition, claims 2-12 depend either directly or indirectly from claim 1 and thus are also in condition for allowance. However, to ensure a thoroughness of the response, the applicant is also addressing each and every one of the Office's reasons for rejecting these independent claims.

With regards to claim 4, the Office admits that *Stewart* and *Kohorn* do not teach the method of claim 1 wherein the commercial is an executable file. The Office then states that such a limitation is old and well known in the art. First of all, the applicant requests the Office to specifically provide such a reference that qualifies as prior art under 35 USC 102 and 103. Secondly, any such reference would require a disclosure of the other elements of claim 1 because *Stewart* and *Kohorn* fail to disclose the elements of claim 1. Thus, the applicant submits that claim 4 is in condition for allowance.

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With regards to claim 5, the Office admits that *Stewart* fails to teach the commercial including an identification code. The applicant agrees with the Office's admission. However, the Office then cites a passage in *Kohorn* stating that it discloses including an identification code in the commercial. The cited passage is totally irrelevant. In column 20 lines 45-55 of *Kohorn*, the only thing that is described is a physical coupon or card, that is provided to a viewer and that includes the viewers name imprinted thereon. This passage does not even approach the suggestion of embedding an identification code within a commercial as claimed. Thus, the applicant submits that claim 5 is in condition for allowance.

With regards to claim 6, the Office admits that *Stewart* and *Kohorn* do not teach the commercial being communicated to a prospect as an attachment to an email. The Office blanketly states that communications by email is well known art and is old. This is not an appropriate position. The Office cannot ignore the elements of claim 1 from which claim 6 depends. It is not well known in the art to communicate a commercial to a prospect that was narrowly identified by an advertiser and communicated to a third party that delivers the commercial to the prospect via email and then monitors the response and communicates the response back to the advertiser. Thus, claim 6 is clearly allowable.

With regards to claim 7, the Office admits that *Stewart* and *Kohorn* do not teach the commercial including a hyperlink to a website. Once again, the position taken by the Office, similar to that regarding claim 6 is inappropriate and the claim is in condition for allowance in that the application is novel and non-obvious and, the claim depends from claim 1 which is also novel and non-obvious.

With regards to claim 8, the Office alleges that *Stewart* discloses tracking by determining whether a commercial is opened. The Office relies on column 2 line 40 for this argument. The applicant respectfully request the Office to read that citation. It is provided herein for convenience:

In a system according to the invention the control node can also be used to monitor patterns of information transfer traffic and reallocate resources accordingly.

The applicant respectfully request the Office to describe how it can read this sentence and

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conclude that *Stewart* discloses tracking by determining whether a commercial is opened. *Stewart* is totally irrelevant in this context. Thus, the applicant submits that claim 8 is in condition for allowance.

With regards to claim 9, the Office admits that *Stewart* and *Kohorn* do not teach tracking by initiating a substantially synchronous link between the prospect and the agent – yet the Office cites an irrelevant passage (apparently from *Stewart*) anyway. However, the lack of such an objection further supports the allegation that the applicant's December 8, 2003 response was not closely reviewed. Claim 9 has been amended to correct this informality. The applicant respectfully requests the Office to indicate the basis for rejecting this claim. As presented, the Office's position is simply a statement that the claim is not disclosed in the cited references.

With regards to claim 10, the Office admits that *Stewart* and *Kohorn* do not teach a substantially synchronous link that comprises a telephone call. Again, claim 10 is allowable as a dependent claim and thus, the applicant submits that this claim is in condition for allowance.

With regards to claim 11, the Office admits that *Stewart* and *Kohorn* do not teach a substantially synchronous link that comprises a chat site. The Office further alleges that a chat site is old and well known in the art of communication. The applicant respectfully objects. First of all, the introduction of a chat site is new technology, especially in relationship to the filing date of this application. The applicant requests the Office to produce references that disclose the use of a substantially synchronous link of a chat site that established communication between an advertiser and a prospect. Unless the Office can produce such a reference, the applicant submits that this claim is allowable.

Please note that the applicant has carefully reviewed the Office's "Response to Arguments" and have found the statements to be disjointed, incomprehensible, and totally void of substance. The applicant has admittedly presented a harsh position in this response and in no way means to breach the duty of respect that is owed to the USPTO examiners. However, the applicant respectfully requests the Office to not further waste the applicant's time and money on this case. The references cited by the Office have been attacked individually and in combination and in no way do the references come close to satisfying the Office's responsibility in the fair

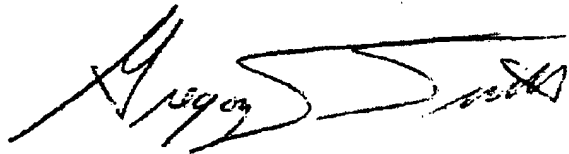
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examination of a patent application.

CONCLUSION

Applicant respectfully submits the claims are allowable over *Stewart and Kohorn* and
respectfully request the Patent Office to move this case towards allowance. The applicant invites
the Patent Office to contact the undersigned at its convenience should the Patent Office believe it
would facilitate prosecution of this application. Applicant thanks the Examiner for consideration of
this application.

Respectfully submitted,



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